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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/816,635      | 04/02/2004  | Robert Greer         | 0644-08             | 1050             |

29439 7590 05/04/2009  
GUERRY LEONARD GRUNE  
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| EXAMINER |
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DICUS, TAMRA

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| ART UNIT | PAPER NUMBER |
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1794

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| MAIL DATE | DELIVERY MODE |
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05/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.





## Office Action Summary

**Application No.**

10/816,635

**Applicant(s)**

GREER ET AL.

**Examiner**

TAMRA L. DICUS

**Art Unit**

1794

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5-7,12,14 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The prior rejections are withdrawn in view of the recent response.

All arguments are moot in view of the new grounds of rejection below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-6, and 12 are rejected under 35 U.S.C. 103(a) as being obvious over Dennison (US 7,001,102) in view of Nakazawa (US 5,238,721).

Regarding claims 1 and 12, Dennison teaches a pre-bonded pavement marking grid and insert pattern (stabilizing body 20 formed of plastic material) comprising: an independent thermoplastic grid section (planar body 22, FIG. 3 and associated text, 5:1-20), having a planar bottom (1:55-59), and being coplanar, comprising individual cells (independent plurality of inserts) therebetween and are in direct contact and adjacent to body 22 forming an intersection by the inter-engagement snug fit (thereby forming a unified pattern as described which prevents dislodging during movement and transportation as claimed); because both body 22 and individual cells 22 make up the entire

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body 20, which is made of plastic, then it implies both 22 and 20 are of the same plastic material.

Dennison suggests the stabilizing body have an attachment or anchoring means or element (3:5-15), while not stating a bottom adhesive layer or their compositions (1, 5-6).

Nakazawa teaches a similar grid wherein both sections have an adhesive layer (3:45-66, 4:1-10, synthetic resin or elastic rubber material embraces thermosetting and thermoplastic adhesive, claims 5-6), under the grid pattern to prevent the attached tiles from moving laterally. See also 3:1-10, 3:30-45, 4:1-9.

It would have been obvious to one having ordinary skill in the art to have modified the pavement marking of Dennison to include the adhesives as claimed because Nakazawa teaches advantages such as adding adhesive to prevent the attached tiles from moving laterally as cited above and as suggested by Dennison.

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennison (US 7,001,102) in view of Nakazawa (US 5,238,721) and further in view of Scharpf (US 5,509,715).

The combination teaches the claimed invention above.

Nakazawa does not expressly refer to the synthetic resin adhesives as thermosetting, thermoplastic, hot melt, or of the recited adhesives as per instant claim 7.

Scharpf teaches a flooring using adhesives for bonding purposes including thermosetting, thermoplastic, hot melt, and ethylene vinyl acetate (EVA) adhesives (6:24-45).

It would have been obvious to one having ordinary skill in the art to have modified the pavement marking of Nakazawa to include the adhesives as claimed because Scharpf teaches all the adhesives are suitable for bonding purposes in flooring or planks (3:25-35, 4:15-30, 6:24-462, Abstract, Scharpf).

To claim 14, because the same materials are employed, the softening point property is inherently expected.

### ***Response to Arguments***

Applicant's arguments filed 02/17/09 been fully considered but are moot in view of the new ground of rejection. The primary reference teaches the planar limitation as well as recited above. Applicant also argues that the reference teaches away from the invention because it's embedded, not applied to the top of a pavement surface, however, this is not in the claims.

Applicant argues the secondary reference, Nakazawa, in alleging that it wouldn't be in the same plane with Dennison or wouldn't add strength. However, the secondary reference was only used to cover the use of adhesive;

the primary reference teaches the planar limitations already. Further, this has not been proven that the combinations won't work. Applicant's claims appear to be more process driven, (i.e. prebonding or pre-application prior to transportation) and thus might be direct to process claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794

April 30, 2009

/Bruce H Hess/  
Primary Examiner, Art Unit 1794